

REMARKS

This communication responds to the Office Action having an electronic filing date of December 22, 2009. Claims 16 and 18 have been amended for typographical reasons. No claims have been canceled. Claims 23-30 have been added. Support for the newly added claims 23-30 can be found at least in paragraphs 34, 44, 47, 49, 51, and 53-59. As such, Applicants respectfully submit that new claims 23-30 do not introduce any new matter. As a result, claims 16-20 and 23-30 remain pending in this application.

The Rejection of Claims Under § 103

Claims 16-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotman (U.S. Patent No. 7,324,969) in view of Lettich (U.S. Publication No. 2002/0049622) and further in view of Woods (U.S. Publication No. 2002/0152174) or Tsunenari (U.S. Patent No. 7,076,449) or Chalmers (U.S. Patent No. 7,266,513) or Tsunenari (U.S. Publication No. 2002/0013744, hereinafter; "Tsunenari-1"), or Buettgenbach (U.S. Publication No. 2002/0032613) or Chalmers (U.S. Publication No. 2002/0152093, hereinafter; "Chalmers-1") or Yashiro (U.S. Publication No. 2003/0033260) or Willoughby (U.S. Publication No. 2003/0217017) or Yang (U.S. Publication No. 2004/0153370) or Lussow (U.S. Publication No. 2004/0153424). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007), the U.S. Supreme Court reaffirmed the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The Court in *Graham* set out an objective analysis for applying § 103 as follows:

"Under § 103, the scope and content of the prior art are to be determined; **differences between the prior art and the claims at issue are to be ascertained**; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined." The Court in

KSR v. Teleflex, at page 1730, quoted the analysis of *Graham* from page 18. (emphasis added)

Applicants will show that the cited references, singly or in combination, neither teach nor suggest all elements of Applicants' claims.

Claim 16, reads, in pertinent part:

by the integrated shipping server:

registering the sender with the shipping vendor based on the shipping information;

interacting with an on-line interface hosted by the shipping vendor, **as if an individual user is directly accessing the on-line interface**;

receiving shipping data pertaining to the shipment **from the shipping vendor**, the shipping data **including data corresponding to a shipping label**.

The Office Action alleges that "Rotman teaches a shipping system that acts as a proxy for the seller and is integrated at a payment processor."¹ Rotman provides "methods and systems for facilitating auction-based online commerce."² Rotman further states, "[s]uch methods and systems may include a rate engine for determining the cost of shipping an item from a location designated by a seller to a location designated by a buyer."³ The Office Action, in an attempt to respond to arguments presented in Applicants' response mailed 9/23/2009, states:

the examiner understands the term register to be the passing of information to another where it is stored. Rotman teaches that the **buyer registers shipping information at a host** so that the information can be automatically sent to the seller/shipper (col. 10, lines 16-18) and that the seller registers data using web based form (col. 3, lines 10-33). Rotman further teaches that in one embodiment the system is capable of "automated fulfillment of shipping". It would have been obvious to try, by one of ordinary skill in the art at the time of the invention to **register the sender with the shipping vendor as is provided in that capabilities of Rotman**, since one of ordinary skill in the art could have pursued the known potential solution of sending shipping information to a

¹ Office Action, page 3

² Rotman, Summary

³ Id.

carrier to provide for automated shipping with a reasonable expectation of success..⁴

The Rotman reference, in the above cited passages, relates to steps by which a typical online auction takes place. For example, Rotman states, "the seller creates a description of the item to be auctioned, typically a combination of words and pictures that depicts the details of the item ... sets various auction ... via ... a web-based form."⁵ Rotman further describes, "if a buyer registers with the host, they do not need to register when they win an auction. The information is sent to the seller automatically by the system."⁶ In other words, Rotman simply teaches that a seller lists an item for auction and a buyer registers with the host to participate in the auction. However, the cited passages are totally silent with respect to the claimed element of *registering (by the integrated shipping server) the sender with the shipping vendor*. As such, Rotman fails to describe this claim element, much less, *based on the shipping information*, as required by the claim 16.

Further, contrary to the allegation by the Office Action in the above quote, registering of the sender with the shipping vendor is not provided by Rotman. Accordingly, the Examiner appears to be relying on his personal knowledge without explicitly taking any Official Notice. Nonetheless, Applicants timely object to any Official Notice in this respect and request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

The Office Action, at page 3, concedes that Rotman does not teach *interacting with an online interface hosted by the shipping vendor*. Instead, the Office Action relies on Lettich to show integration architecture that permits disparate supply chain members. Lettich in the cited passage relates to an integrated shipping and logistic services, and products as follows:

The systems and methods of the present invention integrate shipping and logistics services, operations and products that are currently provided by multiple entities into a vertical system that may be advantageously provided by a single entity to facilitate logistics operations, such as the shipping, transporting, warehousing, and distribution of products ... provides a user ... with "one stop" shopping for shipping and logistics services,

⁴ Office Action, page 5

⁵ Rotman, excerpts from col. 3, line 10-32

⁶ Id., col. 10, lines 16-18

operations and products by acting as a supply chain integrator to assemble and manage resources, capabilities, and technologies of the user's own organization with those of complementary service providers, thereby enabling manufacturers/producers and logistics service suppliers, both asset based and non-asset based ...⁷

According to the above passage, Lettich merely facilitates logistic operations, such as the shipping, transporting, warehousing, and distribution of products. The system of Lettich also assembles and manages resources capabilities, and technologies of the use's own organization with those of the complementary service providers. Nonetheless, the passage is totally silent with respect to the above-quoted claim element. For example, the passage does not describe *interacting (by the integrated shipping server) with an on-line interface hosted by the shipping vendor, as if an individual user is directly accessing the on-line interface*, as required by claim 16.

The Office Action does not address the claim features of “*receiving (by the integrated shipping server) shipping data pertaining to the shipment from the shipping vendor . . . including data corresponding to a shipping label,*” as required by claim 16. Applicants cannot find a passage in the cited patent documents that teaches or suggests this claim element either.

The Office Action at page 7 states “Applicant’s arguments in regards to Woods were persuasive.” Other patent documents cited by the Office Action also fail to teach or suggest the above-discussed claim elements that are missing from the combination of Rotman, Lettich, or Woods.

Accordingly, at least for the reasons set forth above, Rotman, Lettich, Woods, or other cited patent documents, individually or as part of any combination, fail to teach or suggest each and every element of independent claim 16. Therefore, Applicants respectfully submit that there are substantial differences between what is claimed and what the Office Action contended to be shown in the combination of Rotman, Lettich, or Woods. Because the cited documents do not show all of the elements of the claimed subject matter of the independent claim 16, those differences are significant and non-obvious to a person of ordinary skill in the art at the time the application was filed. Furthermore, nothing in the disclosure of Rotman, Lettich, or Woods provides a reason for a person of ordinary skill in the art to seek to combine Rotman, Lettich,

⁷ Lettich, paragraph 0002

and/or Woods in the manner suggested by the Examiner. Accordingly, at least for the reasons articulated above, independent claim 16 and its dependent 17-20 are not rendered obvious by the combination and, thus, are in condition for allowance. Further, each of the dependent claims may also be patentable for its own limitations.

Therefore, Applicants respectfully request that the claim rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4047 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22nd day of March, 2010.

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